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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,480	11/14/2003	Klaus-Peter Klos	EL027PK-1	1203

7590 08/29/2006

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EXAMINER	
LAVILLA, MICHAEL E	

ART UNIT	PAPER NUMBER
1775	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/713,480	KLOS ET AL.	
	Examiner	Art Unit	
	Michael La Villa	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) *21-26 and 28-33* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19, 27, and 34-36* is/are rejected.

7)☒ Claim(s) *20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I in the reply filed on 4 June 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. The requirement is still deemed proper and is therefore made FINAL.
3. Claims 21-26 and 28-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4 June 2006.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

5. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 6, 8, 10, 15, 17, 18, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Regarding Claim 5, it is unclear what medium is being claimed. For a basic pH, as required by Claim 1, it would be expected that the medium must be aqueous. Hence, it is unclear what is being claimed. Does this claim require all solvent to be water?

8. Regarding Claims 8, 17, and 18, it is unclear what is meant by the phrase "in particular." It is unclear what is the claimed concentration range in Claims 8 and 17 and the claimed thickness range in Claim 18.
9. Regarding Claim 10, it is unclear whether these steps must occur after provision of the ecoat, or not.
10. Regarding Claims 6 and 15, it is unclear whether the phrase "is adjusted" is a step to be performed, a characterization of the value of the pH that must be present in the medium, or both.
11. Regarding Claim 35, it is unclear whether the substrate or the substrate coated with formed silicate layer and resin layer is to obtain the claimed exposure to white rust performance level.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

13. A person shall be entitled to a patent unless –

    (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

    (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-14, 16-19, 27, and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Heimann et al. USPN 6,153,080. Heimann et al. '080 teaches

immersion coating a galvanized steel substrate with a silicate solution and then electro-coating the resulting silicate coating with cathodically applied blocked isocyanate epoxy coating. See Heimann et al. '080 (Figure 2; col. 3, lines 33-40; col. 4, line 31 through col. 5, line 6; col. 8, lines 5-25; col. 8, line 44 through col. 9, line 50; and col. 23, line 34 through col. 24, line 24). Since the silicate solutions of Heimann et al. '080 are comparable to those of applicant and since those of applicant possess basic pH, it would be expected that the silicate solutions of Heimann et al. '080 would inherently possess basic pH. Blocked isocyanate is a cross-linking agent.

16. Claims 3, 8, 9, 12, 17-19, 27, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Heimann et al. USPN 6,322,687. Heimann et al. '687 teaches immersion coating a galvanized steel substrate with a basic solution comprising silicate and then electro-coating the resulting silicate coated surface with an organic polymer material. See Heimann et al. '687 (col. 4, lines 21-28; col. 9, lines 18-44; and col. 24, line 40 through col. 25, line 7). The article "Electrocoating or E-Coat" (Reference U on the PTO-892 of the Office Action mailed on 3 March 2006) teaches that provision of an E-coat involves forming a medium with resinous ingredient and applying a current to the medium in a manner that the surface to be coated serves as an electrode. Claims are rejected under section 102(b) because antecedent support is not found in applicant's domestic priority document 60/426,187. Should applicant consider that antecedent support is present, applicant is invited to identify pages and line

numbers where support can be found or otherwise explain how these claims are supported by the priority document. Blocked isocyanate is a cross-linking agent.

17. Claims 1-14, 16-19, 27, and 34-36 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Heimann et al. USPN 6,322,687. Heimann et al. '687 teaches immersion coating a galvanized steel substrate with a basic solution comprising silicate and then electro-coating the resulting silicate coated surface with an organic polymer material. See Heimann et al. '687 (col. 4, lines 21-28; col. 9, lines 18-44; and col. 24, line 40 through col. 25, line 7). The article "Electrocoating or E-Coat" (Reference U on the PTO-892 of the Office Action mailed on 3 March 2006) teaches that provision of an E-coat involves forming a medium with resinous ingredient and applying a current to the medium in a manner that the surface to be coated serves as an electrode. Blocked isocyanate is a cross-linking agent.

Allowable Subject Matter

18. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. The reviewed prior art does not teach or suggest the claimed subject matter of Claim 20. Particularly, there is no teaching or suggestion of drying at the claimed temperature range in of Claim 20 in combination with the other claimed limitations.

Response to Amendment

20. Applicant's amendments and arguments are satisfactory for overcoming the claim objections and section 112, second paragraph rejection of the Office Action mailed on 3 March 2006. These claim objections and section 112, second paragraph rejections are withdrawn.

21. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Heimann et al. "687 of the Office Action mailed on 3 March 2006. Applicant argues that rejection under section 102(b) is inappropriate. Applicant's domestic priority document has been reviewed. As mentioned above, those claims which remain rejected over Heimann et al. '687 under section 102(b) are not found to be supported by applicant's domestic priority document. Applicant contends that reliance on the Electrocoating article evidences that Heimann does not teach every aspect of the claimed invention. Applicant argues that the electrocoating article would not lead one to form an ecoat on a silicate layer. Heimann '687 teaches provision of an ecoat and hence teaches this element. The Electrocoating article was mentioned to explain what constitutes provision of an ecoat, and so its definitional reliance is not improper. Since Heimann teaches coating a silicate layer with an ecoat, any contention that the Electrocoating article does not teach provision of an ecoat on a silicate layer is not germane. Rejection is modified as set forth above.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael La Villa
21 August 2006

MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER